

**Amendment and Response**

Applicant: Daniel R. Marshall

Serial No.: 09/759,867

Filed: January 12, 2001

Docket No.: 10002307-1

Title: PORTABLE INFORMATION STORAGE MODULE FOR INFORMATION SHOPPING

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**REMARKS**

The following remarks are made in response to the Non-Final Office Action mailed March 25, 2005. In that Office Action, the Examiner rejected claims 26 and 27 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-8, 11-30, and 34 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Treyz et al., U.S. Patent No. 6,587,835 ("Treyz"), Gibson et al., U.S. Patent No. 5,557,596 ("Gibson"), and the webpage entitled "VIPERS: the High Ground of 2025" ("VIPERS"). Claims 9, 10, 31-33, and 35-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Frenkiel et al., U.S. Patent Publication No. 2002/0198958 ("Frenkiel"), Gibson, and VIPERS as applied to claims 1-8, 11-30, and 34 above, and further in view of Gioscia et al., PCT Patent Publication No. WO 00/30117 ("Gioscia").

With this Response, claims 1, 15, 26, 27, 29, 30, and 34 have been amended. Claims 1-37 remain pending in the application and are presented for reconsideration and allowance.

With respect to claims 1, 15, 29, 30, and 34, the size and configuration of the memory component has been clarified to include memory components having dimensions sized up to one square millimeter.

**35 U.S.C. §112, Second Paragraph Rejections**

On page 2 of the Office Action, the Examiner rejected claims 26 and 27 under 35 U.S.C. §112, second paragraph. The Examiner indicated that the term "similar to" in claims 26 and 27 is a relative term which renders the claim indefinite. With this Amendment, claims 26 and 27 have been amended such that the term "similar to" has been removed from each claim. Therefore, it is respectfully requested that the rejection of claims 26 and 27 under 35 U.S.C. §112, second paragraph, be withdrawn.

**35 U.S.C. §103 Rejections**

On pages 2-12 of the Office Action, the Examiner rejected claims 1-8, 11-30, and 34 under 35 U.S.C. §103(a) as being unpatentable over Treyz and Gibson, and further in view of VIPERS. The Examiner indicated that neither Treyz nor Gibson discloses a memory component sized approximately one square millimeter, capable of storing gigabytes of data.

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However, the Examiner indicated that VIPERS discloses storage memories that provide multiple terabytes in one square millimeter-sized storage units, citing VIPERS at page 6 of 12. Applicant respectfully disagrees with the Examiner's perception as to the level of storage capabilities disclosed within the VIPERS reference. The VIPERS reference is dated December 9, 1996. Thus, any discussion of storage capacities within VIPERS at time periods post 1996 are mere speculation or future predictions. With reference to FIG. 3-8, Table 2, and the accompanying text, VIPERS discloses storage capabilities as of the date of the publication (December 9, 1996) as one gigabyte of information within a 2.5-square inch-area memory device. The portions of FIG. 3-8 which indicate that 120 gigabytes of information may be contained in a one square centimeter memory device and that a terabyte of information may be contained in a one square millimeter memory device are mere speculation and hopeful predictions estimated to be ascertainable in the future years. The text of VIPERS states that "He (Professor Hesselink) plans for an array that handles 120 gigabytes in one square centimeter within the next few years." The text also states "Super cooled plasma memories are predicted to provide multiple terabytes in one-square-millimeter-sized storage units. (See, VIPERS at pg. 9 of 15). Further, VIPERS specifically discloses that "Reliable holographic storage media in a stacking system and photo reactive polymers are creating one gigabyte in a 2.5-square inch-area," (see, VIPERS at pg. 8 of 15), indicating the level of storage capacity at the time of the document.

At the time of the VIPERS disclosure, December 9, 1996, VIPERS indicated that the storage capabilities are one gigabyte of information in a 2.5-square inch-area memory device. All discussion of greater data storage capabilities in a smaller defined space are mere speculation and predictions. As indicated in the MPEP, disclosure in a reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. (See, MPEP §2121.01).

VIPERS, or any other cited reference, does not disclose a memory component configured having dimensions no larger than one square millimeter and capable of storing gigabytes of data, as claimed in independent claims 1, 15, 29, 30, and 34. VIPERS merely discloses the capability of storing a single gigabyte of data in a 2.5-square inch-area. Predictions and mere speculation of future greater information density on smaller sized

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memory components cannot serve as disclosure of such capabilities. Therefore, it is believed that independent claims 1, 15, 29, 30, and 34, and all claims depending therefrom are patentable distinguishable over the cited prior art.

On pages 12-14, the Examiner rejected claims 9, 10, 31-33, and 35-37 under 35 U.S.C. §103(a). Claims 9, 10, 31-33, and 35-37 are dependent claims which depend from either of claims 1, 30, or 34. As previously discussed, it is believed that independent claims 1, 30, and 34 are patentably distinguishable over the cited prior art. Therefore, it is also believed that dependent claims 9, 10, 31-33, and 35-37 are patentably distinguishable over the cited prior art.

**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1-37 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-37 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Michael R. Binzak at Telephone No. (612) 573-0427, Facsimile No. (612) 573-2005 or Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 23<sup>rd</sup> day of June, 2005.

By Michael R. Binzak  
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